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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,434	12/19/2001	Yoshiaki Yokoo	159-69	2082

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EXAMINER

WEIER, ANTHONY J

ART UNIT	PAPER NUMBER
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1761

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/021,434

Applicant(s)

YOKOO ET AL.

Examiner

Anthony Weier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2006 and 16 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-24, 28-30, 33-36 and 38-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-24, 28-30, 33-36, and 38-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 18-24, 28, 29, 44, 45, and 48-53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to the claims cited, it is not clear as to what the percentage amounts are in reference to: the product beverage or coffee prior to the addition or the milk component.

Claims 48 is confusing in that it is not clear whether or not same is heat sterilized. It is not clear whether this is simply intended use and what is being claimed is the precursor product or beverage prior to sterilization and packaging.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 18-24, 28-30, and 33-36 are rejected under 35 USC 102(b) as being anticipated by Sasagawa et al.

The claims stand rejected for the reasons set forth in the last Office Action and including the following.

The instant claims now call for the strongly basic substance to be either sodium hydroxide or the combination of sodium hydroxide and potassium hydroxide. It should be noted that Sasagawa et al further discloses the presence of sodium hydroxide in combination with the potassium hydroxide (e.g. col. 2, lines 13-26; col. 4, lines 16-18).

4. Claims 30 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Chrysler et al.

Chrysler et al discloses a coffee product containing a milk component that contains sodium hydroxide which had been used to treat the milk component wherein sodium bicarbonate is not present (e.g. col. 1, lines 1-3 and 42-53; col. 2, lines 4-23).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sasagawa et al.

The claims stand rejected for the reasons set forth in the last Office Action.

7. Claims 38-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 11-9190 taken together with Kawai et al.

JP 11-9190 discloses a product containing an amino acid added coffee component with a cow milk component added therein and wherein the product has been heat sterilized (see Abstract). It should be further noted that JP 11-9190 discloses said

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composition having a pH within the range claims (e.g. pH 6.9; see Example 1), the amount of milk called for (e.g. approximately 5% in Example 1), and the amount of amino acid called for (approximately 0.12%; see Example 1; 1.22 g out of a total of 1000 g). It is expected that the amount of sodium bicarbonate added would be less than 0.14 % as it is such a low amount it is not included in the composition breakdown of the product in Example 1 of JP 11-9190. In addition, JP 11-9190 discloses packaging said milk in a hermetically sealed container (e.g. retort can), and it is expected that same would then be capable of marketing.

The claims differ in that JP 11-9190 is silent regarding the use of a basic amino acid (lysine, arginine or histidine). However, it is known to employ arginine, a basic amino acid, in coffee preparations (which also contain a milk component) to improve the flavor of the coffee as taught, for example, by Kawai et al (e.g. Abstract; Examples). It would have been obvious to one having ordinary skill in the art at the time of the invention to have included arginine as the amino acid in JP 11-9190 for the flavor improvement recited in Kawai et al.

It is expected that the addition the basic amino acid in the modified JP 11-9190 product would reduce the amount of emulsifier and/or thickening agent required. In addition, JP 11-9190 discloses the use of an emulsifier in the composition which occupies well below 1% of the product (0.3 g sucrose fatty acid ester in a 52 g coffee extract composition which further includes milk and other ingredients; see translation).

Although Example 1 of JP 11-9190 discloses the use of approximately 12% milk, JP 11-9190 does not limit the milk to any particular amount. It would have been well

within the purview of one skilled in the art to determine such amount, and it would have been obvious to have arrived at such amount as a result of a variable depending on, for example, the degree of dairy flavor desired in the final product.

JP 11-9190 further discloses said composition being lightly sweetened (e.g. 0.06% cane sugar).

8. Claims 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chrysler et al.

Chrysler et al is silent regarding the particular amount of basic substance, coffee solids, and milk component in the beverage as called for in the instant claims.

However, such determination would have been well within the purview of one having ordinary skill in the art, and it would have been obvious to one having ordinary skill in the art at the time of the invention to have incorporated the particular coffee and milk components as a matter of preference depending on the particular flavor desired in the final product. As for the amount of basic substance, it would have been further obvious to have attained such amount through routine experimental optimization.

9. Claims 18-24, 28-30, and 33-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohtake taken together with Sasagawa et al.

Ohtake discloses a coffee product and processing of preparing same wherein a mixture of sodium hydroxide and potassium hydroxide is added to coffee to prevent formation of precipitates during subsequent heat sterilization (e.g. col. 1, lines 52-65; col. 2, lines 56-63). Ohtake additionally discloses that potassium hydroxide and sodium hydroxide are added in amounts as called for in the instant claims, sodium bicarbonate

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(i.e. sodium hydrogen carbonate) is not present, and the product has a pH or 5.8 (e.g. combined hydroxides is 0.25 wt%, see Table 2). Ohtake et al does not employ emulsifiers and thickening agents as called for in the instant claims (see Examples). It is considered inherent that the milk employed in Ohtake is cow's milk, particular since no other milk is referred to and cow's milk is so common.

Ohtake is silent regarding the addition of milk to the coffee product after addition of said mixture and prior to heat sterilizing. However, it is well known to add milk to a coffee treated with potassium salts which is then sterilized as taught, for example, by Sasagawa et al (e.g. col. 4, lines 48-59). It would have been obvious to one having ordinary skill in the art at the time of the invention to have included milk as a matter of preference depending on the particular taste desired in the final product and to have incorporated such step at the time called for in the instant claims for the reasons motivating such processing arrangement in Sasagawa et al.

The claims further call for the amount of coffee and milk in the final product. However, such determination would have been well within the purview of one skilled in the art, and it would have been further obvious to have attained such amounts as a matter of preference depending on the particular flavor or mixture of flavors desired in the final product.

10. Claims 48-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 58-9652 taken together with Kawai et al.

JP 58-9652 discloses a beverage containing milk, coffee, and amino acid and being inherently free of sodium bicarbonate (as same is not mentioned or can be

attributed to being contained in any of the other ingredients). It is considered inherent that the milk employed in Kawai et al is cow's milk, particular since no other milk is referred to and cow's milk is so common.

The claims differ in that JP 58-9652 is silent regarding the use of a basic amino acid (lysine, arginine or histidine). However, it is known to employ arginine, a basic amino acid, in coffee preparations (which also contain a milk component) to improve the flavor of the coffee as taught, for example, by Kawai et al (e.g. Abstract; Examples). It would have been obvious to one having ordinary skill in the art at the time of the invention to have included arginine as the amino acid in JP 58-9652 for the flavor improvement recited in Kawai et al.

The claims further call for the amount of coffee, amino acids, and milk in the final product. However, such determination would have been well within the purview of one skilled in the art, and it would have been further obvious to have attained such amounts as a matter of preference depending on the particular flavor or mixture of flavors desired in the final product.

JP 58-9652 is further silent regarding the particular amount of amino acid as called for in the instant claims. However, such determination would have been well within the art at the time of the invention, and it would have been further obvious to have attained such amount as a result effective variable depending on either the degree of result intended with the use of amino acids in JP 58-9652 or depending on the particular degree of flavor improvement desired in view of the teachings of Kawai et al.

Response to Arguments

11. Applicant's arguments filed 10/31/06 and 11/16/06 have been fully considered but they are not persuasive.

Applicant argues that JP11-9190 is interested in introducing Maillard reaction products that do not affect the coffee taste and thus suggesting a conflict with combining the teachings of Kawai with same wherein it is taught that basic amino acids added to the coffee improves the coffee flavor. It should be noted that JP 11-9190 is interested in avoiding flavor degradation (e.g. Abstract) and that this is likely what is meant in the passages with respect to effecting the taste of same. Certainly, the addition of basic amino acids in Kawai et al does not the beverage from having a coffee flavor and certainly does not degrade said flavor. Kawai et al teaches improving the flavor of the coffee wherein the beverage would still maintain a coffee taste.

All other arguments have been addressed in view of the rejections as set forth above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Weier whose telephone number is 571-272-1409. The examiner can normally be reached on Monday-Thursday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Application/Control Number: 10/021,434

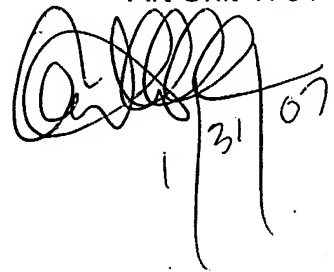
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Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Anthony Weier
January 31, 2007

Anthony Weier
Primary Examiner
Art Unit 1761

A handwritten signature in black ink, appearing to be 'Anthony Weier', with a large, stylized initial 'A'. To the right of the signature, the date '1/31/07' is written vertically.